

REMARKS

Claims 1-25 were previously pending in this application. By this response, Applicant amends claims 1, 6-8, 10, 12, and 15-18, cancels claims 9, 13, 14, and 19-25, and adds new claims 26-94. As a result, claims 1-8, 10, 12, 15-18, and 26-94 are pending for examination with claims 1, 38, 53, and 79 being independent claims. No new matter is added.

Claims 1-18 stand rejected under 35 U.S.C. §112, 2nd paragraph. Applicant has revised claim 1 and believes the metes and bounds of the claim can be clearly determined by one of skill in the art. Withdrawal of the rejection of claims 1-8, 10, 12, and 15-18 as indefinite is requested.

Claims 1-6, 10, 12, and 15-18 stand rejected as being obvious over Shiina in view of Kok in further view of Aeikens. Claims 7-8 stand rejected as being unpatentable over Shiina in view of Kok and Aeikens in further view of McCormick (U.S. 4,557,903). It is the Examiner's contention that the primary reference, Shiina, discloses a method for forming a cell block. Applicant disagrees. It also is the Examiner's contention, apparently based on the misunderstanding that Shiina discloses a cell block forming technique, that it would have been obvious to use an embedding solution in the method of Shiina. Applicant, again, disagrees.

Shiina discloses a system for the automated fixing of cellular samples (that is, chemically preserving the structure of a cell) that are to be transferred to a glass slide – not to forming an embedded cell block as is recited in amended claim 1. Consequently, Shiina does not mention or suggest embedding a sample in a cell block and, of course then, does not disclose or suggest flowing an embedding solution through the cell sample, as is recited in claim 1. Applicant notes that Shiina, in paragraph 0013, does describe a solution that includes 2% carbowax, but this is a secondary fixative solution, as indicated in paragraph 0013, and not an embedding solution.

Shiina discloses a different cytology technique than is claimed; automated fixation of a cell sample that is to be moved from the filter to a slide, such as by scraping the fixed sample off of the filter. The Examiner has contended that it would have been obvious to substitute the embedding

solution employed in Kok for the third reagent described in Shiina. As observed, however, Shiina is not directed at embedding a cell sample (as is Kok) but, instead, at fixing a cell sample. The Examiner has not identified any apparent reason why it would have been obvious to one of skill in the art to substitute the embedding solution taught by Kok for the secondary fixation solution (or the rinsing solution or primary fixative solution) of Shiina – Kok and Shiina involve different cytological techniques. Further, it does not appear that the sample container of Shiina is designed to provide access to an embedded cell block were one of skill in the art actually to have a reason to introduce an embedding solution into the container (and Applicant reiterates that one would not) – as the hypothetical embedded cell block would build up inside the sample container.

Shiina is directed at a partially automated technique – the sample is manually placed onto the filter (see paragraph 0012, “the worker inserts...”). As amended, however, claim 1 recites automatically delivering a cell sample to the filter.

Amended claim 1 distinguishes the combination of Shiina and the other applied references. Amended claim 1 defines a flow through method for forming an embedded cell block. The claimed method comprises, among other aspects, the step of automatically delivering a cell sample to a filter, and the step of automatically flowing an embedding solution through the cell sample and the filter, ultimately forming an embedded cell block. Amended claim 1 is not suggested by the combination of Shiina and any of the secondary references applied in the outstanding office action. Accordingly, the rejection of claim 1 and claims 2-8, 10, 12, and 15-18 dependent thereon, as obvious should be withdrawn.

Claims 1-8, 10, 12, and 15-18 have been rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-18 of US patent No. 6,913,921 in view of Shiina and Kok. Applicant disagrees with the Examiner’s contention that it would have been obvious to employ the device of the patented claims in view of Shiina and Kok but, regardless, acknowledges that a terminal disclaimer will be submitted upon the indication of allowable subject matter

New claims 26-94 have been added, including independent claim 38, 53, and 79, that relate to different methods of forming an embedded cell blocks. Entry and allowance of claims 26-94 is requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance. The Examiner is invited to telephone the undersigned should this case not be considered allowed after entrance of this Amendment.

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